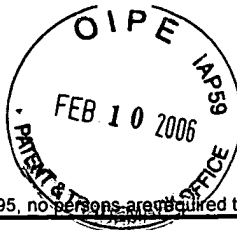


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

9407-26

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on February 8, 2006

Signature

Typed or printed
name

Erin A. Campion

Application Number

10/802,459

Filed

March 17, 2004

First Named Inventor

Yuji Kouno

Art Unit

3623

Examiner

Scott L. Jarrett

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 48,568

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Elizabeth A. Stanek

Typed or printed name

(919) 854-1400

Telephone number

February 8, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE – EXAMINING GROUP 3623**

Attorney's Docket No. 9407-26/JP920010225US1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Kouno et al.

Application No: 10/802,459

Filed: March 17, 2004

For: **COMMODITY SALES NUMBER FORECASTING SYSTEM AND METHOD,
COMPUTER PROGRAM PRODUCT AND STORAGE MEDIUM**

Confirmation No.: 3997

Examiner: Scott L. Jarrett

Group Art Unit: 3623

Date: February 8, 2006

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Erin A. Campion

**REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program, which was extended until further notice on January 10, 2006.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 09-0457.

REMARKS

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed November 8, 2005 (hereinafter "Final

Action") and the Advisory Action mailed January 30, 2006 (hereinafter "Advisory Action"). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Claims 1-16 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over United States Patent No. 5,237,498 to Tenma *et al.* in view of United States Publication No. 2002/0169657 to Singh *et al.* and in further view of *Uncovering the Multiple Impact of Retail Promotion on Apparel Store Performance* by Lam. See Final Action, page 10. Applicants respectfully submit that many of the recitations of the pending claims are not met by the cited references for at least the reasons discussed herein and in Applicants' previously filed Amendments of September 28, 2005 and January 9, 2006 and that a *prima facie* case of obviousness has not been made by the Office Action of June 28, 2005 (hereinafter "the Second Action"), the Final Action and/or the Advisory Action. Therefore, Applicants respectfully request review of the present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicants will only discuss the recitations of the independent Claim 1.

For example, Claim 1 recites:

A computer implemented commodity sales number forecasting system for calculating a forecast sales number of a commodity at each shop for the commodity sold in a group of shops within a predetermined district, the computer implemented system comprising:

a computer implemented district sales number forecasting section configured to calculate the forecast sales number of a commodity within said predetermined district for each unit advertising district residing within said predetermined district performing sales promotion activity at the same time by use of a predetermined advertising medium; and

a computer implemented shop sales number forecasting section configured to calculate the forecast sales number at each shop by distributing the forecast sales number of said commodity in said unit advertising district to each shop within said unit advertising district.

Both the Second Action and the Final Action (referred to collectively herein as "Office Actions") are more than 80 pages in length, but both fail to specifically address the recitations of the claims. In particular, both Office Actions make general assertions pointing out what the cited references discuss without specifically addressing the claim recitations. This does not satisfy the Office's burden of obviousness. In particular, to establish a *prima facie* case of obviousness, the

prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See* M.P.E.P. § 2143. If each of the recitations is not addressed, the Office Action has not shown that the references disclose or suggest "**all**" of the recitations of the claims." Thus, a *prima facie* case of obviousness has not been made for at least these reasons and the reasons discussed in Applicants' Amendments of September 28, 2005 and/or January 9, 2006, the contents of which are hereby incorporated herein by reference as if set forth in their entirety.

Furthermore Responsive to Applicants' request for support for the assertions in the Second Action by citation to specific portions of a reference that addresses the specific recitations of the claims, the Final Action states that Applicants' Amendment of September 28 is deficient and, therefore, "the Official Notice Statement(s) are taken to be admitted as prior art." *See* Final Action, page 8. In particular, the Final Action states that adequate traversal is a two-step process. First, Applicants must state their traversal on the record. Second, Applicants must specifically point out the supposed errors in the Office Action. *See* Final Action, page 8. The Final Action states that Applicants' response lacked prong 2. Applicants disagree and submit that Applicants have satisfied both prongs.

Specifically, the Final Action states that Applicants' Amendment of September 28 fails to "specifically point out the supposed errors in the Office Action." *See* Final Action, page 8. However, Applicants specifically stated in Applicants' September 28 Amendment that "Applicants request that the Examiner support such assertions with citations to a reference or references as the Official Notice taken in the Office Action appears to be so vague **that Applicants cannot properly address the combination of the "Official Notice" with the cited references.**" *See* Applicants' September 28 Amendment, page 12.

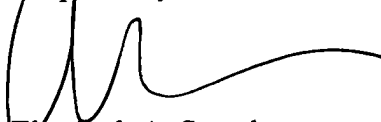
As discussed in M.P.E.P. 2144.03, Applicants request for support was valid and the Final Action fails to provide such support. Instead, the Final Action creates a circular

Attorney's Docket No.: 9407-26/ JP920010225US1
Application Serial No.: 10/802,459
Filed: March 17, 2004
Page 4

argument. In particular, Applicants requested support for the "Official Notice" and stated that Applicants could not properly address the rejection based on the combination of the "Official Notice" with the cited references. Instead of supplying the requested support, the Final Action asserts that Applicants' response is deficient for not adequately addressing the rejections, which Applicants stated could not be properly addressed, and then states that the inadequate response allows the "Official Notice" to be treated at "prior art." See Final Action, page 8. Applicants respectfully submit that additional information, previously requested by Applicants, is needed before a proper response can be made. Thus, treating the "Official Notice" statements as prior art because Applicants allegedly failed to properly address such statements is clearly improper. Applicants once again requested that the Examiner support such assertions with citations to a reference or references as the Official Notice taken in the Final Action appeared to be so vague that Applicants cannot properly address the combination of the "Official Notice" with the cited references. See Applicants' January 9, 2006 Amendment, page 13. Again, the Advisory Action failed to provide the requested information.

Accordingly, for at least these reasons, Applicants respectfully submit that the Second Action, Final Action and Advisory Action fail to provide a *prima facie* case of obviousness and, therefore, request that the present application be reviewed and that the rejections be reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,



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